

## REMARKS

### I. PRELIMINARY REMARKS

Claims 1, 7, 11, 22, 24 and 26 have been amended. Claim 3 has been canceled. Claims 29-34 have been added. Claims 1, 2, 4-12, 14, 15, 17, 20-26 and 29-34 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

### II. PRIOR ART REJECTIONS

#### A. The Rejections

Claims 1, 2, 4-6, 8, 9, 10, 12, 14, 20, and 23 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,578,499 to Kroll ("the Kroll patent"). Claims 3, 11, 15 and 24-26 have been rejected under 35 U.S.C. § 103 as being unpatentable over the Kroll patent.<sup>1</sup>

Claim 7 has been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,464,821 to Phillips ("the Phillips patent").

Claim 17 has been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,187,405 to Rudin ("the Rudin patent").

The rejections under 35 U.S.C. §§ 102 and 103 are respectfully traversed to the extent that they are applicable to the claims as amended above. Reconsideration thereof is respectfully requested.

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<sup>1</sup> The Office Action also indicated that claims 21 and 22, which depend from independent claim 7, were rejected based on the Kroll patent. [Office Action at pages 3 and 9.] However, in view of the fact that independent 7 was not rejected based on the Kroll patent, applicant has assumed for the purpose of this response that the references to claims 21 and 22 in the statements of rejection based on the Kroll patent were typographical errors. **Clarification is hereby requested.**

**B. Discussion Concerning the Rejection of Claims 1, 2, 4-6 and 8 Based on the Kroll Patent**

Independent claim 1 has been rewritten so as to call for the combination of elements substantially similar to that previously recited in claim 3. Accordingly, the rejection of claims 1, 2, 4-6 and 8 under 35 U.S.C. § 102 has been rendered moot. The remarks below are based on the presumption that the rejection of claim 3 under 35 U.S.C. § 103 is now applicable to claims 1, 2, 4-6 and 8.

Independent claim 1 calls for a combination of elements comprising “an at least substantially opaque sheet defining a front side, a rear side and a plurality of side edges, the at least substantially opaque sheet being selected from the group consisting of an **8 ½ inch x 11 inch** at least substantially opaque sheet, an **8 ½ inch x 14 inch** at least substantially opaque sheet, and a **210 mm x 297 mm** at least substantially opaque sheet,” “at least one strip of adhesive” and “a plurality of liners positioned over the at least one strip of adhesive material.” The respective combinations defined by claims 2, 4-6 and 8 include, *inter alia*, the elements recited in claim 1.

The Kroll patent, which is directed to a wind resistant picnic system that may include a tablecloth with adhesive, fails to teach or suggest the claimed combinations. For example, the tablecloth 10 illustrated in Figure 1 includes a plurality of adhesive/liner strips 12 arranged in “+” patterns at the corners of the bottom surface, while the tablecloth illustrated in Figures 7 includes a plurality of adhesive/liner strips 92 on the top surface and, in some instance, the adhesive pattern illustrated in Figure 1 on the bottom surface. [Column 4, lines 44-49.] The Kroll patent fails, however, to teach or suggest that the picnic table tablecloths disclosed therein are 8 ½ inches by 11 inches in size, or 8 ½ inches by 14 inches in size, or 210 mm x 297 mm in size (i.e. letter size, legal size or A4 size). This would not be particularly surprising to one of ordinary skill in the art given the fact that they are .... **picnic table tablecloths**.

Faced with this clear difference between the invention defined by independent claim 1 (prior claim 3) and the disclosure of the Kroll patent, as well as the lack of a

suitable teaching reference, the Office Action simply based the obviousness determination on the following conclusory statement:

It would have been an obvious matter of design choice to modify Kroll by providing the sheet to have a size of 8.5x11 inches, because it would involve a change in the size the sheet. A change in size is found to be within the level of ordinary skill in the art.

[Office Action at page 9.]

Applicant respectfully submits that there are a variety of errors associated with the above-quoted statement and the conclusion of obviousness based thereon. For example, the Office Action failed to so much as attempt to explain why one of skill in the art would find 8 ½ inch x 11 inch (or 8 ½ inch x 14 inch or 210 mm x 297 mm) picnic table tablecloth desirable. Most notable, however, is the fact that the Office Action impermissibly relied on a *per se* rule of obviousness. The Federal Circuit has this to say about *per se* rules of obviousness:

[t]he use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention-including all its limitations-with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But ***reliance on per se rules of obviousness is legally incorrect and must cease.***

*In re Ochiai*, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), emphasis added. See also *In re Cofer*, 148 USPQ 268, 271 (CCPA 1966) (“it is the facts appearing in the record, rather than prior decisions in and of themselves, which must support the legal conclusion of obviousness under 35 U.S.C. § 103”). The MPEP includes a similar admonition. In particular, MPEP § 2144.04 indicates that the Examiner may only use the rationale used by a court “***if the facts*** in a prior legal decision ***are sufficiently similar*** to those in an application under examination.” [Emphasis added.] The present Office Action failed to so much as attempt to apply the facts of any prior legal decision to the facts at issue here.

In view of the foregoing, applicant respectfully submits that the Office Action failed to establish a *prima facie* case of obviousness as to independent claim 1 and that the rejection of claims 1, 2, 4-6 and 8 under 35 U.S.C. § 103 should be withdrawn.

### C. Discussion Concerning the Rejection of Claims 9-12 Based on the Kroll Patent

Independent claim 9 is directed to “printable media.” The claimed printable media comprises “an at least substantially opaque sheet defining a front side, a rear side and at least first and second intersecting side edges, each of the first and second side edges defining opposing longitudinal ends, **one of longitudinal ends of each of the first and second side edges defining a common longitudinal end.**” Independent claim 9 also calls for “a **substantially continuous first strip** of adhesive material on one of the front and rear sides of the at least substantially opaque sheet adjacent to the first side edge and extending substantially **from one longitudinal end of the first side edge to the other longitudinal end of the first side edge**” and “a **substantially continuous second strip** of adhesive material on the one of the front and rear sides of the at least substantially opaque sheet adjacent to the second side edge and **extending substantially from one longitudinal end of the second side edge to the other longitudinal end of the second side edge.**” [Page 7, lines 8-19.] The respective combinations defined by claims 10-12 include, *inter alia*, the elements recited in claim 9.

The Kroll patent fails to teach or suggest the claimed combinations. Referring to Figure 1, which is reproduced here with annotations to aid the discussion, the Kroll patent discloses a tablecloth 10 with a plurality of adhesive/liner strips 12 arranged in “+” patterns at the corners of the bottom surface. The Examiner has apparently taken the position that adhesive strips A and B together correspond to the claimed “**substantially continuous first strip** of adhesive material” and adhesive strips C and D together correspond to the claimed “**substantially continuous second strip** of adhesive material.”

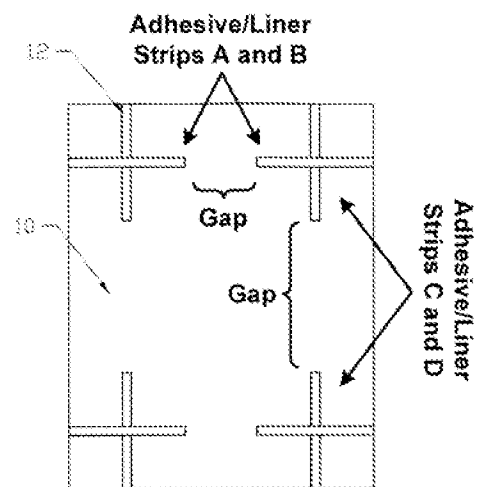


Figure 1 of the Kroll Patent

Applicant respectfully submits that there is no reasonable interpretation of the phrase “substantially continuous” that would read on the Kroll “strips.” Adhesive strips A and B are separated by a significant gap, as are adhesive strips C and D. In fact, the gap between adhesive strips C and D is longer than the individual adhesive strips themselves.

As the Kroll patent fails to teach or suggest each and every element of the combination recited in independent claim 9, applicant respectfully submits that claims 9, 10 and 12 are patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

Turning to dependent claim 11, applicant respectfully submits that the Kroll patent also fails to establish a *prima facie* case of obviousness with respect to independent claim 9 and that claim 11 is patentable for at least the same reasons as claim 9. The rejection of claim 11 under 35 U.S.C. § 103 should, therefore, also be withdrawn.

#### **D. Discussion Concerning the Rejection of Claims 14, 23 and 24 Based on the Kroll Patent**

Independent claim 14 is directed to “printable media.” The claimed printable media comprises “a sheet defining a front side, a rear side and at least first and second ***intersecting*** side edges, each of the first and second side edges defining opposing longitudinal ends, one of longitudinal ends of each of the first and second side edges defining ***a common longitudinal end.***” Independent claim 14 also calls for “a plurality of first strips of adhesive material on one of the front and rear sides of the sheet adjacent to the first side edge and extending ***substantially from one longitudinal end of the first side edge to the other*** longitudinal end of the first side edge” and “a plurality of second strips of adhesive material on the one of the front and rear sides of the sheet adjacent to the second side edge and extending ***substantially from one longitudinal end of the second side edge to the other*** longitudinal end of the second side edge.” Independent claim 14 also recites “a plurality of first liners respectively

positioned over the plurality of first strips of adhesive material” and “a plurality of second liners respectively positioned over the plurality of second strips of adhesive material.” The respective combinations defined by claims 23 and 24 include, *inter alia*, the elements recited in claim 14.

The Kroll patent fails to teach or suggest the claimed combinations. For example, and referring to Figure 7, which is reproduced below with annotations, the Kroll patent discloses a tablecloth 90 with a plurality of adhesive strips 92. Even assuming for the sake of argument that the top two Kroll adhesive strips 92 correspond to the claimed “plurality of first strips of adhesive material ... adjacent to the first side edge and extending substantially from one longitudinal end of the first side edge to the other longitudinal end of the first side edge,” there simply is no “plurality of second strips of adhesive material ... adjacent to the second side edge and extending ***substantially from one longitudinal end of the second side edge to the other*** longitudinal end of the second side edge.” Note that claim 14 indicates that the first and second side edges are “***intersecting*** side edges” and that “one of longitudinal ends of each of the first and second side edges defin[es] ***a common longitudinal end.***”

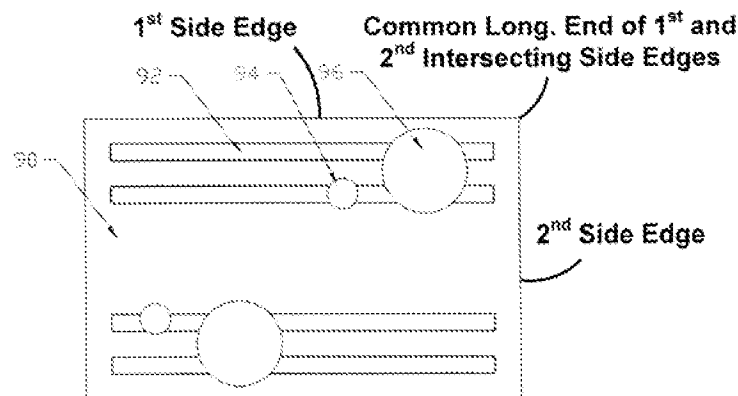


Figure 7 of the Kroll Patent

As the Kroll patent fails to teach or suggest each and every element of the combination recited in independent claim 14, applicant respectfully submits that claims 14 and 23 are patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

Turning to dependent claim 24, applicant respectfully submits that the Kroll patent also fails to establish a *prima facie* case of obviousness with respect to independent claim 14 and that claim 24 is patentable for at least the same reasons as claim 14. The rejection of claim 24 under 35 U.S.C. § 103 should, therefore, also be withdrawn.

**E. Discussion Concerning the Rejection of Claims 15, 25 and 26 Based on the Kroll Patent**

Independent claim 15 is directed to “printable media.” The claimed printable media comprises “a sheet,” “a first strip of adhesive material ... extending substantially from one longitudinal end of the first side edge to the other longitudinal end of the first side edge,” “a second strip of adhesive material ... extending substantially from one longitudinal end of the second side edge to the other longitudinal end of the second side edge” and “**first and second liners** respectively covering the first and second strips of adhesive material and including **mitered ends** adjacent to the common longitudinal end of the first and second side edges.” The respective combinations defined by claims 25 and 26 include, *inter alia*, the elements recited in claim 15.

The Kroll patent fails to teach or suggest the claimed combinations. For example, and referring to Figure 1, the Kroll liners are in the shape of an “+” and do not have mitered ends.

Faced with another clear difference between a claimed invention and the disclosure of the Kroll patent, as well as the lack of a suitable teaching reference, the Office Action based the obviousness determination on a nothing more than a conclusory statement of Examiner opinion. More specifically, the Office Action stated:

It would have been obvious to one having ordinary skill in the art to modify Kroll by providing mitered ends shape to the liners for facilitating the removability thereof. A change of shape is found to be within the level of ordinary skill in the art.

[Office Action at page 9.] Applicant respectfully submits that there are a variety of errors associated with the above-quoted statement and the conclusion of obviousness based thereon. For example, the Office Action failed to so much as attempt to explain why, in

an arrangement where the release liner is in the shape of an “+” and the ends of the “+” are not even associated with the corner of the underlying sheet or the corner of another liner, it would have been obvious to have mitered ends. Instead, the Examiner asserted without any supporting evidence, indicated that “providing mitered ends shape to the liners for facilitating the removability thereof.” Such a statement is insufficient to support a conclusion of obviousness. “This factual question of motivation is material to patentability, and **[may] not be resolved on subjective belief and unknown authority.**” *In re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), *emphasis added*.

The Office Action also appears to have again impermissibly relied on a *per se* rule of obviousness. As noted above, reliance on *per se* rules of obviousness is legally incorrect.” *In re Ochiai*, 37 USPQ2d at 1133.

In view of the foregoing, applicant respectfully submits that the Office Action failed to establish a *prima facie* case of obviousness as to independent claim 15 and that the rejection of claims 15, 25 and 26 under 35 U.S.C. § 103 should be withdrawn.

#### **F. Discussion Concerning the Rejection of Claim 20 Based on the Kroll Patent**

Independent claim 20 is directed to “printable media.” The claimed printable media comprises “an at least substantially opaque sheet,” “a horizontally extending strip of pressure sensitive adhesive ... adjacent to the first horizontally extending side edge,” “a vertically extending strip of pressure sensitive adhesive ... adjacent to the first vertically extending side edge,” “a plurality of closely spaced horizontally extending release liners together covering at least a substantial majority of **the** horizontally extending **strip** of pressure sensitive adhesive” and “a plurality of closely spaced vertically extending release liners together covering at least a substantial majority of **the** vertically extending **strip** of pressure sensitive adhesive.”

The Kroll patent fails to teach or suggest the claimed combinations. Referring to Figure 1, which is reproduced on the following page with annotations to aid the discussion, the Kroll tablecloth 10 includes a plurality of adhesive/liner strips 12



arranged in “+” patterns at the corners of the tablecloth. With respect to the claimed “horizontal” elements, the Examiner has apparently taken the position that the adhesive in strip A and the adhesive in strip B together correspond to a **single** strip of adhesive,<sup>2</sup> while the liner in strip A and liner in strip B correspond to a **plurality** of liners. The Examiner has also apparently taken the same position with respect to the “vertical” elements of the claim. Applicant respectfully submits that there is no reasonable interpretation of the claim that would allow the Examiner to read the spaced Kroll strips of adhesive on the a single strip of adhesive and also read the identically sized and shaped Kroll release liners on a plurality of release liners.

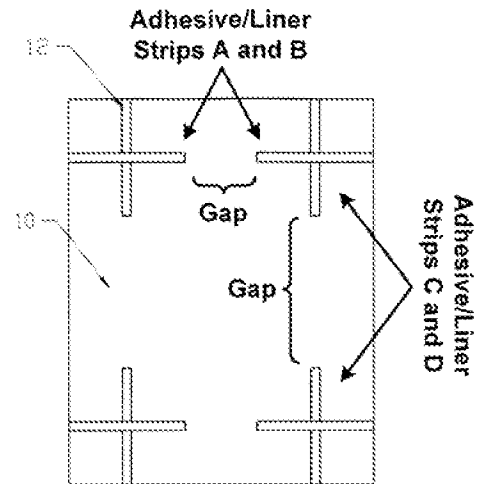


Figure 1 of the Kroll Patent

As the Kroll patent fails to teach or suggest each and every element of the combination recited in independent claim 20, applicant respectfully submits that claim 20 is patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

#### G. Discussion Concerning the Rejection of Claim 7 Based on the Phillips Patent

Independent claim 7 calls for a combination of elements comprising “an at least substantially opaque sheet,” “**a single strip of adhesive material defining a width that is less than the width of the at least substantially opaque sheet** on one of the front and rear sides of the at least substantially opaque sheet adjacent to a first one of the plurality of side edges” and “a plurality of liners.”

<sup>2</sup> Note that the claim refers to “**the** horizontally extending **strip** of pressure sensitive adhesive.”

The Phillips patent fails to teach or suggest the claimed combination. For example, the adhesive layer 22 appears to extend over the entire surface of the Phillips asphalt sheet 20.

As the Phillips patent fails to teach or suggest each and every element of the combination recited in independent claim 7, applicant respectfully submits that claim 7 is patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

#### **H. Discussion Concerning the Rejection of Claim 17 Based on the Rudin Patent**

At the outset, applicant notes that the Examiner has apparently taken the position that portions of the Rudin sheet identified by reference numeral 74 in Figures 9-11, i.e. the margins of the sheet that are outside the perforations 72, correspond to the claimed “liners.” To the extent that this was not merely a typographical error, applicant hereby requests that the Examiner explain how the “liners” can be on the same side of the adhesive as the underlying sheet in order to clarify the issues for appeal.

Turning to claim 17 itself, the claim calls for a combination of elements comprising “a sheet defining a front side, a rear side and at least first and second *intersecting* side edges ... one of longitudinal ends of each of the first and second side edges defining a *common longitudinal end*,” “a first strip of adhesive material ... adjacent to the first side edge and *extending substantially from one longitudinal end of the first side edge to the other longitudinal end of the first side edge*,” “a second strip of adhesive material ... *extending substantially from one longitudinal end of the second side edge to the other longitudinal end of the second side edge*,” “first and second liners” and “a liner corner member.”

The Rudin patent fails to teach or suggest the claimed combination. For example, and referring to Figures 9-11, the adhesive strips 76, which are respectively covered by the backings 78, only extend along the horizontal edges of the sheet. As such, even assuming for the sake of argument that some of the adhesive in the top horizontal adhesive strip 76 also extends partially along one of the Rudin vertical side edges (i.e.

the claimed “second intersecting side edge”), there simply is no strip of adhesive material that “extends substantially **from one longitudinal end**” of the vertical side edge “**to the other longitudinal end**” of the vertical side edge, as called for in claim 17.

As the Rudin patent fails to teach or suggest each and every element of the combination recited in independent claim 17, applicant respectfully submits that claim 17 is patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

### **III. NEWLY PRESENTED CLAIMS 29-34**

Newly presented claims 29-33 depend from independent claim 20 and, accordingly, are patentable for at least the same reasons as claim 20.

Newly presented claim 34 depends from independent claim 1 and, accordingly, is patentable for at least the same reasons as claim 1.

### **IV. CLOSING REMARKS**

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant’s undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such

fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,

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Date

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